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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,562	12/18/2001	David R. Bartkowiak	01-178	2677

719 7590 01/03/2005

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PEORIA, IL 616296490

EXAMINER

KIM, CHRISTOPHER S

ART UNIT PAPER NUMBER

3752

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,562

Applicant(s)

BARTKOWIAK ET AL.

Examiner

Christopher S. Kim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12-19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12-19 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The response filed October 25, 2004 is acknowledged.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. Claims 2-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of dependent claims 2-9 is not consistent with their parent claim 1.

Claim Rejections - 35 USC § 102

4. Claims 1, 4, 7, 8, 9, 19, 22, 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hojyo et al. (6,024,056).
5. Claims 1, 3, 4, 7, 8, 9, 19, 21, 22, 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pruyn (1,225,855).

Claim Rejections - 35 USC § 103

6. Claims 10, 12, 14, 15, 16, 17, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wich (4,408,718) in view of Kenny (959,546).

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With respect to claims 10, 12, 16, 17, 18, Wich discloses the limitations of the claimed invention with the exception of the high pressure seal connecting the first bore and the second bore. Wich uses an O-ring 124. Kenny discloses a tubular/cylindrical seal 4. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have replaced the O-ring of Wich with the tube of Kenny to seal the fluid passage and to guide the upper body and cartridge valve assembly during assembly (Kenny, page 1, lines 85-92).

With respect to claims 14 and 15, Wich in view of Kenny discloses the claimed invention except for thickness of the seal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the seal (at least a portion thereof) less than 1mm thick, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

7. Claims 5, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pruyn (1,225,855).

Pruyn discloses the claimed invention except for thickness of the seal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the seal (at least a portion thereof) less than 1mm thick, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

8. Claims 10, 13, 16, 17, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wich (4,408,718) in view of Kohlman (5,944,319).

Wich discloses the limitations of the claimed invention with the exception of the high pressure seal connecting the first bore and the second bore. Wich uses an O-ring 124. Kohlman discloses a tubular/cylindrical seal 44. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have replaced the O-ring of Wich with the seal of Kohlman to provide multiple and backup sealing surfaces (Kohlman, column 3, line 20).

Response to Arguments

9. Applicant's arguments filed October 25, 2004 have been fully considered but they are not persuasive.

Applicant argues that Prior does not disclose a high pressure seal. Applicant's argument fails for two reasons. First, the term "high pressure seal" appears in the preamble as the name of the device. In itself, it breaths neither life nor meaning into the claim. No limitation recited within the body of the claim further defines "high pressure." Second, the term "high" is a relative term that is neither defined by the specification nor the claims. Rather than considering the term indefinite, it has been considered a broad recitation of the name of the device without further defining the device.

Applicant's argument directed to 20,000 psi is not commensurate in scope with the claimed invention. Claim 7 recites "said seal is exposed to pressures in excess of

20,000 PSI." The functional recitation merely requires the ability to so perform. Hojyo does not prohibit his seal from being exposed to 20,000 PSI.

Applicant argues that Hojyo's opposing engine parts are not mating or in abutment with one another. Applicant's argument is not commensurate in scope with the claimed invention. The claims do not limit the first and second mating parts to be mated with each other. Even so, the Hojyo's engine is a single engine. The first and second mating parts are mated.

Applicant argues that the prior art seal does not expand radially. The claims merely require the tube be "expandable radially." Pruyn discloses, on page 1, lines 51, "fit was snug." If Pruyn's seal can be snug fit, it has the capability to expand radially. Similarly, Kenny discloses, on page 1, lines 88-92, a "driving fit" to provide air and water tight joint.

In response to applicant's argument that Kenny is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Kenny is reasonably pertinent to the particular problem with which the applicant was concerned. Kenny is concerned with air and water tight joints (Kenny, page 1, lines 85-92).

Applicant argues that Kohlman requires machined and beveled seats which are clamped together using bolts. Applicant's claimed invention does not preclude such elements.

Applicant argues that Kohlman's seal is not a tube that fits into first and second bores of the mating parts. Kohlman's seal is a tube 44 that fits into first mating part 12 and second mating part 14.

Applicant' argues that Kohlman's seal does not expand radially. As indicated above, applicant's claimed invention merely requires the ability to expand radially. Even so, Kohlman's truncated section deflects with subsequent application of internal pressure. The deflection has a radial component.

In response to applicant's argument that Kohlman is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Kohlman is reasonably pertinent to the particular problem with which the applicant was concerned. Kohlman is concerned with high pressure seals (Kohlman, column 1, lines 15-21).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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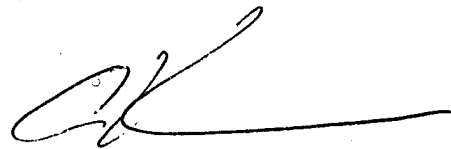
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. Kim whose telephone number is (571) 272-4905. The examiner can normally be reached on Monday - Thursday, 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel can be reached on (571) 272-4919. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher S. Kim
Primary Examiner
Art Unit 3752

CK